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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,126	12/20/2001	Eric Henry Baller	31862.000065	2357
23387	7590	03/27/2006	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			GAYESKI, MICHAEL R	
		ART UNIT	PAPER NUMBER	
		2143		

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/028,126	BALLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael R. Gayeski	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 December 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 and 20-31 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 and 20-31 is/are rejected.  
 7) Claim(s) 1,30 and 31 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. The amendment filed 12/21/2005 has been entered. Claim 19 has been canceled. Accordingly, claims 1-18 and 20-31 remain pending in the instant application.

### ***Claim Objections***

2. Claims 1, 30, and 31 are objected to because of the following informalities:

- Claim 1, 2<sup>nd</sup> paragraph reads “[...] for storing response from a central system [...] ,” which appears to be incorrect.
- Claims 30 and 31 refer to an apparatus, when the base claim is directed towards a method.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-3, 6-7, 9, 10-12, 15, 16, and 17-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. With regard to **claims 1-3, 6-7, 9, 10-12, 15, 16, and 21**, since Applicant's specification indicates that the functionality of the invention is implemented in software, the claims comprise software *per se* (i.e. functional descriptive material), which does not fall into one of the four statutory categories of invention, and is therefore non-statutory. In order for functional descriptive material to be statutory, the claim must have a

limitation that expressly indicates appropriate *physical* hardware implementing the functionality of the invention. In the instant case, the rejection may be overcome by adding a claim limitation that is clearly limited to physical embodiments (i.e. "a memory for storing messages").

***Claim Rejections - 35 USC § 112***

6. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites the limitation "*a message generator for creating an application layer message document including a unique machine name and password combination in a format suitable for transmission over a network [...].*" Regarding this limitation, Applicant argues in the reply filed 1/13/2006 that the claimed username and password is unique for *each* machine, which provides a way to individually password protect each machine (Applicant's Remarks, page 8, paragraph 5 – page 9, paragraph 1). Examiner has searched Applicant's specification, and is unable to find an enabling disclosure for this limitation. The only mention of an identifier and password in the specification can be found in paragraph 77 (page 19) of Applicant's specification. Examiner notes that said paragraph does not indicate that the identifier (UserID) and password are unique to each machine, or that the identifier and password are even sent in a message. Indeed,

the abbreviation of UserID indicates to the Examiner that the identifier and password are used to authenticate *users*, not computers.

Admittedly, Figure 5 of Applicant's specification shows a sample SOAP message which includes an authorization token field (<AuthenticationToken>), but corresponding passage on paragraph 45 (page 11) of Applicant's specification does not indicate how this token is related to a machine identifier or password.

Furthermore, Examiner's search of the prior art indicates that the use of a password to identify a *machine* is not well known in the art. Rather, the use of an identifier *and password* is typically reserved for authenticating *users*, not *machines*.

Since Applicants limitation of "a unique machine name and password" is not supported by the specification, nor was it well known in the art at the time of Applicant's invention, it would require undue experimentation for one of ordinary skill in the art at the time the invention was made to determine how to arrive at Applicant's claimed invention.

7. Claims 2, 5, and 9 recite the same limitation as claim 1, and are rejected for similar reasons. Claims 3, 4, and 6-7 are rejected by virtue of their dependency on claim 1.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1 recites the limitation "*a message generator for creating an application layer message document including a unique machine name and password combination in a format suitable for transmission over a network [...].*" As discussed immediately above, the limitation fails to pass the enablement requirement. Based on the prosecution record and Applicant's specification, it appears that Applicant is using the term contrary to its ordinary meaning in the art. In general, an identifier/password combination is for authenticating *users*, not machines. Based on paragraphs 45 and 77 of Applicant's disclosure, it appears as if Applicant is intending to use the term "machine name and password" to broadly cover known authentication methods. However, the use of the term in such a way is inappropriate, as an identifier/password is a *specific* way to provide authentication, not a generic term.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

For purposes of examination, the claim limitation will hereinafter be interpreted as "[...] including a unique machine name and information for authenticating and

authorizing each machine in a hypertext document [...]." Amending the claim to cover the scope of paragraph 45 (page 11) of Applicant's specification would overcome this rejection, as well as the rejection under 35 USC 112 1<sup>st</sup> paragraph.

11. Claims **2, 5, and 9** recite the same limitation as claim 1, and are rejected for similar reasons. Claims **3, 4, and 6-7** are rejected by virtue of their dependency on claim 1.

12. Claim **6** recites the limitation "the message" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim, as it is unclear whether "the message" refers to the first message sent by the message generator (paragraph 1 of claim 1) or the subsequent messages (paragraph 3 of claim 1). Examiner will hereinafter interpret the claim as referring any of the messages.

#### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims **1-9** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2005/0102388 (hereinafter 'Tabbara').

15. With regard to **claim 1**, Tabbara teaches the substantive limitations of the claim, including:

a message generator for creating an application layer message document including a *unique machine name and information for authenticating and authorizing each machine* (i.e. private key pair) in a hypertext format suitable for transmission over the network, the message including information for identifying the machine (Paragraphs 27 and 88);

a receiver for receiving and storing responses from a central system (Paragraphs 92 and 93).

the message generator subsequently creating messages using the unique *machine name and information for authenticating and authorizing each machine* (Paragraph 89).

16. With regard to **claim 2**, Tabbara further teaches the network is a TCP/IP network (Paragraphs 26 and 27).

17. With regard to **claim 3**, Tabbara further teaches the network is a wireless network (Paragraph 28).

18. With regard to **claim 4**, Tabbara further teaches the connection is established through a gateway device that provides protocol or address translation (Paragraph 35).

19. With regard to **claim 5**, Tabbara further teaches storing the unique name and password in a memory on the central system (Paragraphs 88 and 89).
20. With regard to **claim 6**, Tabbara further teaches the message is a registration message (Paragraph 89).
21. With regard to **claim 7**, Tabbara further teaches the registration message includes identifying information (paragraph 86), information on the type of machine (Paragraph 85), network address and availability (Paragraph 85: All TCP/IP messages inherently include an address).
22. With regard to **claim 8**, Tabbara further teaches memory for storing a token indicating that the machine is registered, and inhibiting subsequent sending of registration messages (Paragraph 88).
23. With regard to **claim 9**, Tabbara further teaches the registration message includes a non-unique identifier and the response from the server includes a unique identifier to be used by the machine in subsequent messages (Paragraph 88).
24. Claims **10 and 13-31** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,754,664 (hereinafter 'Bush').
25. With regard to **claim 10**, Bush, in the same field of endeavor, teaches:

a message generator for sending a registration message to a central system, the registration message including a unique identifier (Column 6, line 62 – Column 7, line 6);

a scheduler for periodically activating the message generator according to the stored schedule (Column 9, lines 32-67);

a receiver, activated for a predetermined time after the generator is activated for receiving the messages from the central system ( Column 8, lines 4-15).

26. With regard to **claim 13**, Bush further teaches the receiver receives a schedule from a central system and stores the schedule in memory (Column 9, lines 32-67: Computer implemented methods inherently store all data in a memory).

27. With regard to **claim 14**, Bush further teaches the receiver receives a schedule from a central system in response to a registration message (Column 9, lines 32-39; and Column 10, line 46 – Column 11, line 3: The console may change all DataCollector properties)

28. With regard to **claim 15**, Bush further teaches the remote machine is a gateway device that provides protocol or address translation to further machines (Column 6, lines 25-43).

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29. With regard to **claim 16**, Bush further teaches the gateway device that maintains the schedule and interacts with further machines as required to satisfy the schedule (Column 6, lines 25-43).

30. With regard to **claim 17**, it is rejected for similar reasons as claim 10, as the connection by Bush over the Internet (Column 4, lines 13-25 i.e. TCP/IP connections) inherently are two-way connections.

31. With regard to **claim 18**, it presents no substantive limitations over claim 10, and is rejected for similar reasons.

32. With regard to **claims 20 and 21**, they present no substantive limitations above those of claim 10, and are rejected for similar reasons.

33. With regard to **claim 22**, Bush, in the same field of endeavor, teaches:  
queueing one or more request messages on the server (Column 11, lines 23-32);  
logging the one or more request messages on the server (Column 11, lines 42-50);  
sending a polling message from the asset to the server (Column 11, lines 4-14);  
sending one of the one or more request messages to the asset in response to the polling message Column 11, lines 4-14);

receiving the message at the server and reconciling the responsive message with the logged result (Column 11, lines 12-14);  
continuing to send request messages to the asset until the queue is empty (Column 12, lines 16-23).

34. With regard to **claim 23**, Bush further teaches the step of sending a polling message comprises sending polling messages at a predetermined interval (Column 11, lines 23-25).

35. With regard to **claim 24**, Bush further teaches:

detecting a fault at the asset requiring interactivity; and sending one or more polling messages to the server in response to the fault (Column 12, lines 8-23).

36. With regard to **claim 25**, Bush further teaches the step of sending one or more polling messages comprises sending one or more poling messages at a second interval shorter than the predetermined interval (Column 11, lines 23-25: The polling interval is variable).

37. With regard to **claim 26**, Bush further teaches the predetermined interval is set by the server (Column 11, lines 23-28).

38. With regard to **claim 27**, Bush further teaches that the server sends one or more queued messages to the asset in response to any message from the assets received by the server (Column 12, lines 16-23).

39. With regard to **claim 28**, Bush further teaches the server sends one or more of the queued messages to the asset in response to any message from the asset received by the server (Column 11, lines 4-14).

40. With regard to **claim 29**, Bush further teaches the message from the server includes a request for establishing an interactive session and the responsive message from the asset establishes an open connection through which subsequent messages are sent (Column 12, lines 16-23).

41. With regard to **claims 30 and 31**, they present no substantive limitations above those of claims 15 and 16, and are rejected for similar reasons.

#### ***Claim Rejections - 35 USC § 103***

42. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

43. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bush in view of Tabbara.

44. With regard to claims 11 and 12, Bush teaches the substantive limitations of the base claim, but is silent on storing a token indicating the machine is registered, or on inhibiting subsequent registrations in response to the token. Tabbara, in the same field of endeavor, teaches the same (Tabbara, Paragraphs 89 and 90). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine the invention by having nodes of Bush run additional monitoring software as taught by Tabbara, with the motivation of allowing the system of Bush to effectively manage mobile devices (Tabbara, Paragraph 9).

By this rationale, claims 11 and 12 are rejected.

### ***Response to Arguments***

45. Applicant's arguments, see "Remarks" page 9, paragraphs 1 and 9, filed 12/21/2005, with respect to the rejection(s) of claim(s) 1 and 10 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tabbara and Bush.

### ***Conclusion***

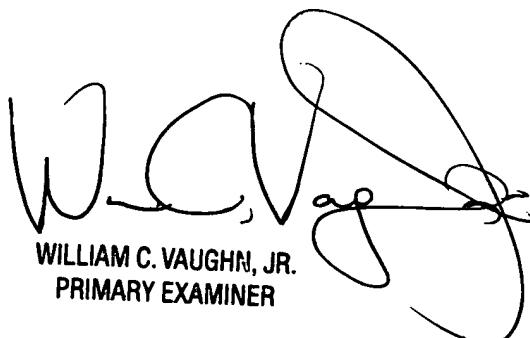
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Gayeski whose telephone number is 571-272-0978. The examiner can normally be reached on M-F: 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael R Gayeski  
Examiner  
Art Unit 2143

mrg  
3/20/2006



WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER